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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,948	11/14/2005	Martine Seu-Salerno	085516-9004-00	2392
23409 7590 05/08/2008 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202				
EXAMINER				
ELLIS, SUEZU Y				
ART UNIT		PAPER NUMBER		
1615				
MAIL DATE		DELIVERY MODE		
05/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/527,948

**Applicant(s)**

SEU-SALERNO ET AL.

**Examiner**

Suez Ellis

**Art Unit**

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 3/8/07
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group III invention (claims 16-18) in the reply filed on April 3, 2008 is acknowledged.

Examiner acknowledges the incorporation of claims 16-18 into Group III invention.

### ***Priority***

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119(e), a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the

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application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge

under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on March 8, 2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

The disclosure is objected to because of the following informalities:

On pages 8-9 and pg. 14-15 of the specification, the specification recites the liquid phase being aqueous and having mineral particles (titanium dioxide) grafted with hydrophobic groups, such as perfluoroalkyl phosphates. However, on pages 11 and 15-16, the specification recites the liquid phase being an oily and having mineral particles (titanium dioxide) grafted with lipophobic groups (titanium dioxide particles grafted with fluorinated groups), such as perfluoroalkyl phosphates. It is unclear how the titanium dioxide treated with perfluoroalkyl phosphate group is considered both hydrophobic and lipophobic. Please clarify.

It is suggested that applicant incorporate the following headings to make the specification more clear and organized:

TITLE OF THE INVENTION  
CROSS-REFERENCE TO RELATED APPLICATIONS  
BACKGROUND OF THE INVENTION  
    (1) Field of the Invention.  
    (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.  
BRIEF SUMMARY OF THE INVENTION  
BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S)  
DETAILED DESCRIPTION OF THE INVENTION  
CLAIM OR CLAIMS

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 13, claim language recites "a cosmetic composition made up in whole or in part of a solid powder" and further recites the composition comprises a liquid phase. Since the composition requires a liquid phase, it is unclear how the composition can be made up in whole of a solid powder. Please clarify. Further, the claim language recites the cosmetic composition is in a powder form (line 9). It is unclear how the cosmetic composition can be in a powder form since there is a liquid

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phase in the composition. Further it is unclear how the cosmetic composition is transformed into a cream upon application. The claim language does not clearly describe how this would be performed upon application. Please clarify. Further, claim language recites the terminology "a solid", in lines 4-5. It is unclear if this solid is the same as the solid powder in line 2. If they are the same, proper antecedent basis is necessary. Please clarify.

With respect to claims 16 and 17, it is unclear how the cosmetic composition is transformed into a water-based/oil-based composition upon application. The claim language does not clearly describe how this would be performed upon application. Please clarify.

Claims 13, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the steps of transforming the cosmetic composition is in a powder form into a cream upon application (claim 13) and transforming the cosmetic composition into a water-based composition/oil-based composition upon application.

Claims not specifically addressed are indefinite due to their dependency.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (US 5,645,903) in view of the teachings of Verdon et al. (US 5,063,050).

With respect to claim 13, Tanaka et al. discloses a cosmetic composition made up in whole or in part of a solid powder, the composition comprising a liquid phase (water) in encapsulated form or immobilized on the surface of a solid, a gelling agent (agar or gelatin) for the liquid phase and mineral or organic particles having surface properties that give the particles a low affinity for the liquid phase (col. 2, lines 41-49; col. 3, lines 26-49). Tanaka et al. fails to expressly disclose the cosmetic composition is in a powder form that is transformed into a cream upon application. However, Tanaka et al. does disclose the cosmetic composition is in a solid form which imparts a watery, fresh sensation when applied, and the solid composition can be used as a cream (col. 2, lines 41-59; col. 5, lines 26-29). It is well known in the art for pressed powders to impart a creamy texture when applied, as taught by Verdon et al. (col. 3, lines 45-47). It would have been obvious to one of ordinary skill in the art to modify the initial form of the solid composition to be a powder depending on the desired application (e.g. pressed powder).

Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (US 5,645,903) in view of the teachings of Verdon et al. (US 5,063,050) and further in view of Funatsu (US 5,622,693).



With respect to claim 14, the modified Tanaka et al. addresses all the limitations of claim 13, and further discloses the mineral particles comprise fluorinated titanium dioxide particles (Table 1). However, the modified Tanaka et al. fails to expressly disclose the gelling agent is a starch modified by carboxymethyl groups. It is well known in the art to use gelatin or carboxymethyl starch as a gelling agent in solid cosmetic compositions, as taught by Funatsu (col. 2, lines 21-56). Therefore, the carboxymethyl starch is considered to be functionally equivalent to the gelatin. It would have been obvious to one of ordinary skill in the art to modify the type of gelling agent used, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 16, the modified Tanaka et al. discloses the cosmetic composition is a water-based composition (col. 3, lines 19-20; col. 5, lines 18-20), and therefore is considered to remain an aqueous-based composition when applied.

Claims 13, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kashimoto (US 2002/0012682) in view of Yamamoto (US 6,548,454) and further in view of the teachings of Verdon et al. (US 5,063,050).

With respect to claims 13, 15 and 17, Kashimoto discloses a cosmetic composition made up in whole or in part of a solid powder, the composition comprising a liquid phase (oil) in encapsulated form or immobilized on the surface of a solid, fluorinated mica, and mineral or organic particles having surface properties that give the

particles a low affinity for the liquid phase (fluorinated titanium dioxide) (Example 1). While Kashimoto fails to expressly disclose the fluorinated mica being used as a gelling agent, however it is well known in the art for fluorinated mica to have that property, as evidenced by Yamamoto et al. (claim 1). Examiner further notes these ingredients are the same as that recited in applicant's specification, therefore are considered to have similar properties and functions, especially the fluorinated titanium dioxide being lipophobic (see pg. 11, 1st paragraph of applicant's specification). While Kashimoto fails to expressly disclose the cosmetic composition transforming from a powder into a cream, Kashimoto does disclose the cosmetic composition is a pressed powder (example 1). It is well known in the art that pressed powders impart a creamy texture when applied, as taught by Verdon et al. (col. 3, lines 45-47). Therefore, the cosmetic composition is considered to be transformed from a powder form into a cream upon application.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kashimoto (US 2002/0012682) in view of Yamamoto (US 6,548,454) and further in view of the teachings of Verdon et al. (US 5,063,050) and further in view of Ohno et al. (US 5,023,065).

With respect to claim 18, the modified Kashimoto addresses all the limitations of claims 13 and 17, however fails to expressly disclose the fluorinated mica being modified with potassium. Ohno et al. teaches it is well known in the art to use a fluorinated mica modified with potassium in a powder foundation (Example 1). It would

have been obvious to one of ordinary skill in the art to use the fluorinated mica modified with potassium of Ohno et al. in order to improve the extensibility, adherence and moldability of the cosmetics (col. 1, lines 18-20; col. 29, lines 37-46). Further, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sato et al. (WO 03/003990) discloses a powder cosmetic composition comprising a liquid phase, a gelling agent (carboxymethyl starch) and mineral/organic particles having surface properties that give the particles low affinity for the liquid phase (fluorine-treated titanium oxide).

Oka et al. (WO 02/056844; US 2004/0028710) discloses a powder cosmetic composition comprising a liquid phase, a gelling agent and mineral/organic particles having surface properties that give the particles low affinity for the liquid phase (fluorine-treated titanium oxide).

***Telephone/Fax Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suez Ellis whose telephone number is (571) 272-2868. The examiner can normally be reached on 8:30am-5pm (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharon Kennedy can be reached on (571) 272-4948. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SE

*/Sharon E. Kennedy/  
Primary Examiner, Art Unit 1615*